

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 77897-US1	
		Application Number 08/845,897-Conf. #8846	Filed April 28, 1997
		First Named Inventor M Ashraf Imam et al.	
		Art Unit 1771	Examiner H. Vo

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

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November 17, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

*Total of 1 forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of: Imam et al.
Serial No.: 08/845,897
Filed: 08/28/1997
For: POROUS METAL/ORGANIC POLYMERIC COMPOSITES
Examiner: Vo, Hai
Art Group Unit: 1771

Honorable Commissioner of Patents
PO Box 1450
Alexandria, VA 22313-1450

November 17, 2006

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This Request is in response to the Office Action of 05/30/2006, the Advisory Action of 09/19/2006 and the Supplemental Advisory Actions of 10/02/2006 and 11/01/2006. It is submitted with a Notice of Appeal and Petition for Extension.

Claims 1-28 are pending in the application. Claims 5, 6, 8-10, and 12-16 have been withdrawn pursuant to a restriction/election of species requirements. No claims are presently allowed.

An amendment to claims 26-28 was submitted on 10/03/2006 but was not entered. The claims currently stand as they were amended on 04/06/2006.

Claim Rejections – 35 U.S.C. § 102

Claims 1-3, 11, 19, 22, 23, 25, 26, and 28 have been rejected under 35 U.S.C. § 102(e) as allegedly anticipated by JP 08-245810. As the reference is a foreign patent publication, it is assumed that the rejection should be under § 102(a). The publication date is 09/24/1996, which is less than one year before the filing date of the present application, 04/28/1997. The reference may be removed as a reference by a declaration under 37 C.F.R. § 1.131. The declarations from the inventors submitted on 07/13/2006 include a copy of an invention disclosure showing that the invention was reduced to practice no later than 07/30/1996, which is before the date of the reference. The disclosure was also witnessed by Robert F. Brady and C.S. Pande on 07/30/1996.

The disclosure shows that a composite was made from a 6-8% density Al foam filled with phthalonitrile resin. This composite had a 92-94 vol.% polymeric matrix. Based on this evidence, JP 08-245810 should be removed as reference.

In the Supplemental Advisory Action of 10/02/2006, the Examiner stated that since the showing in the declaration is not commensurate with the scope of the claims and does not fairly represent the scope of the claims, the declaration isn't effective to antedate the reference. However, it is not required that the declaration be commensurate with the scope of the claims. "The 37 CFR 1.131 affidavit or declaration must establish possession of either the whole invention claimed or something falling within the claim (such as a species of a claimed genus), in the sense that the claim as a whole reads on it. MPEP 715.02, first paragraph (emphasis added). Also, "A reference or activity applied against generic claims may (in most cases) be antedated as to such claims by an affidavit or declaration under 37 CFR 1.131 showing completion of the invention of only a single species, within the genus, prior to the effective date of the reference". MPEP 715.02 II (emphasis added). Predictability, as discussed in MPEP 715.03, is not an issue in this case, as the genus is only a range of volume %.

In the Supplemental Advisory Action of 11/01/2006, the Examiner stated that "Since the volume % shown in the declaration is completely different from the species of the claimed genus ... Applicant' [sic] arguments are misplaced and irrelevant to the scope of the claims." It is not clear to what "the species of the claimed genus" refers to in the advisory action. As used in the first sentence of MPEP 715.02, "species of the claimed genus" refers to the species which was shown in the declaration to have been invented before the date of the reference. This sentence from MPEP 715.02 also refers to this as "something falling within the claim." The Examiner's statement implies that the species shown in the declaration is something other than the "species of the claimed genus." This does not reflect the meaning of MPEP 715.02.

In the present case, the "species of the claimed genus" had a 92-94 vol.% polymeric matrix. The "claimed genus" has 60-95 vol.% polymeric matrix, as recited in present claim 1. There can be no question that the species shown in the declaration falls within the claimed range and is a "species of the claimed genus." The species is not "completely different," as stated by the Examiner, as it is a species of the claimed genus. Thus, the declaration is effective to antedate the reference.

The Examiner also stated in the Supplemental Advisory Action of 11/01/2006 that "It is

technically erroneous to compare apples with oranges." It is not understood to what the apples and oranges are meant to be analogous. Neither one is a genus that includes the species of the other.

Claim Rejections – 35 U.S.C. § 103

Claims 4 and 7 have been rejected under 35 U.S.C § 103(a) as being allegedly unpatentable over JP 08-245810 and further in view of Tsang (US 4,605,595). As explained above, JP 08-245810 should be removed as reference.

Claims 17, 18, 20, 21, 24, and 27 have been rejected under 35 U.S.C § 103(a) as being allegedly unpatentable over JP 08-245810. As explained above, JP 08-245810 should be removed as reference.

Claims 1-4, 7, 11, 17-22, and 26-28 have been rejected under 35 U.S.C § 103(a) as being allegedly unpatentable over Tsang in view of JP 08-245810. As explained above, JP 08-245810 should be removed as reference.

In view of the foregoing, it is submitted that the application is now in condition for allowance.

In the event that a fee is required, please charge the fee to Deposit Account No. 50-0281, and in the event that there is a credit due, please credit Deposit Account No. 50-0281.

Respectfully submitted,



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